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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/502,810	02/11/2000	Jonathan S. Brecher	103544.127	5710

7590 01/08/2004

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EXAMINER

ALLEN, MARIANNE P

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 01/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/502,810

Applicant(s)

BRECHER, JONATHAN S.

Examiner

Marianne P. Allen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

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DETAILED ACTION

Claims 24-44 have been cancelled and claims 45-50 newly introduced.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 45-50 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claimed method is a method for use in deriving chemical structural information. The steps comprise analyzing an input name and manipulating the characters of the input name. Under certain conditions, a portion (of something unnamed) is sent to an output buffer. The method steps as set forth do not produce a concrete, tangible, and useful result nor a credible, specific, and substantial result. Note that no chemical structural information is derived by the method steps as set forth in the preamble.

To the degree that the claims are computer implemented methods (as inferred by the claim limitations to output buffers), the claims are non-statutory.

Claim Rejections - 35 USC § 112

Claims 45-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

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art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

Basis for new claims 45-50 was stated to be on pages 6-13 of the specification. The method steps as recited are not seen here. There does not appear to be contemplation of a discrete method comprising the steps as recited in the claims. For example, the specification discloses scanning from left to right not scanning in the absence of a direction. For example, the specification discloses copying the input name as a text string to a temporary buffer for manipulation, not manipulating the original input name. For example, the specification discloses treating other characters such as spaces, commas and apostrophes in particular ways that the claims omit.

Claims 45-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This is an enablement rejection.

The claims as written do not result in deriving chemical structural information. At best, the claims as written manipulate information and send some unspecified portion of information to an output buffer. As such, the claims do not provide a concrete, tangible, and useful result such that one of ordinary skill in the art would know what to do with the information produced.

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Note that the predetermined text strings or predetermined sequences to be searched for are not set forth and that the predetermined text strings or predetermined character to be substituted are not set forth.

Note that the conditions required for prepending are not set forth.

Note that the actions for claim 48 are not specified.

In the absence of such information, at worst the claims embrace arbitrarily manipulating string characters to no useful purpose and at best the claims are an invitation to experiment to determine string manipulations that will provide useful chemical structural information.

Claims 45-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 45-50 are confusing in that no chemical structural information referred to in the preamble is derived by the method steps as set forth.

Claims 45-50 are confusing in that some of the steps generate information which is never used. For example, potential name fragments are marked, but this marking is never used. For example, enclosing marks are counted but this number is never used. For example, the depths of the enclosing marks are monitored but this information is never used.

Claims 45-50 are confusing in that it is unclear if the scanning steps are performed simultaneously or sequentially.

Claims 45-50 are confusing in that “prepending” implies inserting before something present in the output buffer, but the claim does not make clear what is or is not present in the output buffer.

Claim 45 is confusing in reciting “mark potential name fragment boundaries.” It is not known what delimits a potential name fragment boundary such that one of ordinary skill in the art would know what to mark or how to mark it.

Claim 45 is confusing in reciting “prepending a portion.” A portion of what? It is unknown what the first and second conditions that must be met are.

Claim 46 is confusing as examination of hyphens is already set forth in claim 45. It is unclear if a second examination or different examination of hyphens is intended.

Claim 48 is confusing as it is not known what action on the input name must be performed. The limitation that the input name is within a temporary buffer is confusing as claim 45 does not specify where the analysis nor scanning take place.

Claim Rejections - 35 USC § 102

Claims 45-46 and 48-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Boyer et al. (U.S. Patent No. 5,345,516).

Boyer et al. discloses a method, computer system, and computer software for parsing text strings representing a chemical name and generating the correct structural diagram from this. The text string is broken into fragments according to particular rules to facilitate the analysis, the fragments are associated with the appropriate chemical structural information using delimiters and connection tables. See abstract; claims; Appendix J; Figure 12; column 1, line 44, through column 2, line 1; column 12, line 32, through column 14, line 40.

Boyer et al. implicitly scans the input name to mark potential name fragment boundaries by breaking the text string into fragments, counts parentheses which are enclosing marks monitors the depths for connectivity, examines all characters in the string (including hyphens), replaces specific text strings with other text strings and sends information to an output buffer. Boyer et al. doesn't specifically recite maintaining the same length buffer during parsing (see claim 48) but as Boyer et al. does not change buffer length presumably it has stayed the same. Boyer et al. scans for context of characters and converts characters as needed in parsing (see claims 49-50). Note that in claims 45, 49, and 50 particular strings are not being looked for nor are they changed to something in particular.

Boyer et al. does not disclose changing a hyphen to an @ sign when it is immediately followed by a space and not immediately preceded by a comma, a plus, or a slash character (see claim 47).

Conclusion

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

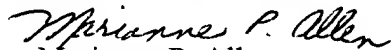
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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 571-272-0712. The examiner can normally be reached on Monday-Thursday, 5:30 am - 1:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571-272-0722. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


Marianne P. Allen
Primary Examiner
Art Unit 1631

mpa